

**REMARKS**

Claims 1, 2, 4-7 and 28-34 are pending in the application.

Claims 1, 2, 4-7 and 28-34 have been rejected.

Claims 2, 4, 7, 33 and 34 have been canceled, without prejudice.

Claims 1, 6, 28-32 have been amended, as set forth herein.

I. REJECTION UNDER 35 U.S.C. § 102

Claim 28 was rejected under 35 U.S.C. § 102(b) as being anticipated by Rainey (US Patent 6,168,351). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Rainey reference describes a retaining wall anchoring system. (Abstract). The modular retaining wall 10 includes a plurality of wall blocks 14 stacked atop each other to form the retaining wall. (Col. 2, lines 39-50; Figure 2). Each of the wall blocks 14 may include a locking mechanism to allow adjacent blocks to lock with each other to increase wall stability. (Col. 2, lines 55-67). Several points of the retaining wall 10 are secured to the earth or rock using tieback connections at multiple points along a particular wall block 14 (one or more of the stacked wall blocks may include

tieback connections). (Col. 2, lines 31-39; Figure 3). An attachment mechanism 42 secures the tieback rod 38 to the wall block 14. The attachment mechanism 42 includes a pair of elongated force distribution members 44, 46 that extend from one tieback rod 38 to the next to distribute force. A pair of washers 48, 50 partially surround the upper and lower distribution members 44, 46 and fitted about the tieback rod 38 and a conventional threaded fastener 56 secures the washers 48, 50 and the distribution members 44, 46 thus securing the tieback rod 38 to the wall block 14. (Col. 3, line 44 thru Col. 4, line 4; Figure 2).

Independent Claim 28 recites a wale for use in bracing a retaining wall. The wale includes a back wall having an opening therein and operable for receiving a tieback rod therethrough. A front wall having a channel formed therein extends from a first end of the wale to a second end of the wale and includes a second opening for receiving the tieback rod therethrough. A plurality of connecting walls connect the back and front walls to form at least one chamber between the back and front walls.

The final Office Action, in essence, argues that (1) Rainey's washers 48, 50 are equivalent to Applicant's back wall and front wall having a channel formed therein, and (2) Rainey's attachment mechanism 42 is of unitary construction. The interpretation and reasoning of the Office Action is not well-taken.

First, though Rainey's washers 48, 50 appear to include a channel therein, such channel in the washers does not extend from a first end of the wale to a second end of the wale. This feature is recited in Claim 28. The washers 48, 50 are component parts of the attachment mechanism 42 and, when Rainey's attachment mechanism 42 is defined as a "wale" (necessarily extending from

one tieback rod 38 to the next tieback rod 38), the washer 50 does not include a channel that extends from one end of the attachment mechanism to the other end (from tieback rod to tieback rod).

Second, the distribution members 44, 46 do not “connect” the back washer 48 to the front washer 50. This feature recited in Claim 28 is not present in Rainey. The distribution members 44, 46 are adjacent to the washers 48, 50 and are not “connected” to them.

Finally, the Applicants respectfully submit that those elements of Rainey as identified in the final Office Action fail to disclose a wale that “is of a unitary construction” as recited in Claim 28 and described in Applicants’ application. As shown in Figures 2 and 4 of Rainey, and described therein, the back washer 48, front washer 50 and plurality of distribution members 44, 46 (identified in the final Office Action as the back wall, front wall and connecting walls of Applicant’s wale, respectively) form an attachment mechanism 42 that is used to attach the tieback system to a horizontally extending wall block 14. This attachment mechanism 42 includes two separate force distribution members 44, 46 and two separate flanged washers 48, 50. Rainey, Col. 3, lines 49-51, 61-63. As a result, the attachment mechanism 42 and its four elements are not of a unitary construction, but are separately constructed members. Though assembled into a unit, as argued in the Office Action, the unit is not of unitary construction as contemplated and described in Applicant’s specification. (See, Application, paragraphs 0010, 0031, 0057). Applicants respectfully submit that an ordinary person of skill in the art would understand that the identified elements of Rainey (identified in the final Office Action as the wale) together are not “of a unitary construction.”

With respect to the Examiner’s position, Claim 28 recites that the “wale is of unitary construction” – not simply “unitary”. Thus, Rainey’s attachment mechanism 42 (including two

members 44, 46 and two flange washers 48, 50) may arguably be a “unit” - but when viewed as a whole - it is not “of unitary construction.”

For at least one of these reasons, the Office Action has failed to establish that Rainey anticipates each and every element of independent Claim 28. Accordingly, the Applicants respectfully request that the final rejection of Claim 28 be withdrawn and that Claim 28 be passed to allowance.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claim 28.

## II. REJECTION UNDER 35 U.S.C. § 103

Claims 1, 2, 6, 28, 30, 33 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber (US Patent 5,435,669) in view of Fox (US Patent 5,765,970). Claims 4, 5, 7, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber (US Patent 5,435,669) in view of Fox (US Patent 5,765,970), as applied to Claims 1, 6 and 28 above, and further in view of Enduro Systems DuroThread Fastener & Hanging System (“Enduro”). Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey (US Patent 6,168,351).<sup>1</sup>

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis

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<sup>1</sup> For the same reasons set forth above with respect to the 102 rejection of independent Claim 28 over Rainey, dependent Claim 29 fails to disclose, teach or suggest these elements.

to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. (*MPEP* § 2142).

Weber teaches hollow polymeric elongate lagging members that are stacked in a horizontal disposition to form a wall. (Col. 1, lines 10-24, lines 51-52). The lagging or panel members (87,

74) of Weber are horizontal construction members, and these members are not used for bracing the vertical members. In fact, the panel members (87, 74) are designed and used to form the retaining wall panels themselves (extending horizontally lengthwise), which are inserted into the vertical pilings. (Abstract; Figure 1). In addition, Weber provides -- in only one of the many described embodiments -- a lagging member having a plurality of internal tubular passages 81 formed between the front surface 77 and back surface 78 because it is desirable for a uniformly constructed wall, such as a wall constructed from the wall or lagging members (87, 74), to address water weepage. (Col. 7, lines 43-48). Thus, it is clear that the lagging or wall members (87, 74) of Weber are used to construct the wall itself, and do not and are not intended to function in Weber as a conventional “wale” member.

Because Weber’s members are constructed using rotary molding (or bag molding, or other molding technique, and produce a shell with end caps), they are usually hollow and relatively low in strength (Col. 6, lines 8-18). Weber teaches that when these members need additional strength, the members can (1) be filled with concrete, sand or gravel (Col. 8, lines 39-61), (2) be formed to include external, short elongate strengthening channels 66 (Col. 6, lines 35-58), (3) include steel structural members inserted therethrough (Col. 10, lines 15-17), or (4) utilize a different lagging member 184 specially designed to engage tieback rods or cables 210 (Col. 12, line 27 thru Col. 13, line 39, Figures 17-19).

Fox is directed to hollow timbers of various lengths with the timbers placed on top of each other (lengthwise) to form a wall. (Col., 1, lines 5-36). Vertical whaler posts are provided and the horizontal timbers are held to the whaler posts with U-clips. (Col. 1 lines 44-55). The wall member

timbers 12 of Fox constitute the wall portions. It is apparent that Fox's vertical whaler posts 44 stabilize and brace the retaining wall 10.

Applicant has made substantial amendments to independent Claims 1, 6 and 28. These claims now recite (among other amendments) a tieback rod extending through the front and back walls, and a fastener disposed in the channel of the wale and coupled to the tieback rod. Fox fails to disclose, suggest or teach (1) use of a tieback rod extending through the front wall and back wall of a wale, and (2) a channel portion in the wale extending from a first end of the wale to the second end of the wale. While Fox may arguably teach a plurality of upper and lower reinforcing walls to provide internal stiffening, the purpose behind the stiffening is to generally provide an increase in strength to the wall member (it is not used as a traditional "wale"). Since Fox does not utilize tieback rods that extend through both the front and back walls of the wall member, Fox does not, and fails to, recognize or teach the need for such reinforcing walls within a wale configuration that receives a tieback rod through both the front and the back walls of the wale.

Weber appears to teach only one possible configuration of a lagging member using tieback rods (or cables). See, Figures 17-19. This particular configuration lacks the Applicant's recited channel extending from the first end to the second end of wale. Moreover, the configuration of Weber's wall member would be extremely difficult, if not impossible, to manufacture using a pultrusion process (i.e., having pultruded composite material), hence Weber only describes that the lagging members are manufactured using rotary or bag "molding". Applicant, on the other hand, has devised a wale member that may use pultruded composite material with a distinctive cross-section operable for use with tieback rods. This increases the wale's strength for withstanding the

forces exerted by tieback rods on the wale and beneficially allows for the construction of the wale member to be “of unitary construction” using a pultrusion process (i.e. pulled through a die having the desired cross-sectional shape).

For these reasons, Applicant respectfully submits that the proposed Weber-Fox combination does not disclose, teach or suggest every element of Applicant’s independent claims 1, 6 and 28, as amended.<sup>2</sup>

Accordingly, the Applicant respectfully requests withdrawal of all the § 103(a) rejections of Claims 1, 2, 4-7 and 28-34 (claims 2, 4, 7, 33, 34 have been canceled).

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<sup>2</sup> The Enduro reference does not add any significant teaching or cure any of the noted deficiencies in the proposed Weber-Fox combination.



III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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Robert D. McCutcheon  
Registration No. 38,717

P.O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3632 (direct dial)  
(972) 628-3600 (main number)  
(972) 628-3616 (fax)  
E-mail: *rmccutcheon@munckbutrus.com*